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Docket No.
227076/014
HMG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Fredric Goldstein

Serial No. : 09/340,303 Art Unit: 3721

Filed : June 28, 1999

For : RIBBON CURLING AND SHREDDING DEVICE

April 20, 2000

INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents
Washington D.C. 20231

Sir:

Applicants respectfully submit this Information Disclosure Statement pursuant to 37 C.F.R. §§1.97 and 1.98 in order to comply with the duty of disclosure under 37 C.F.R. §1.56. The enclosed Information Disclosure Citation (Form PTO-1449) identifies one (1) reference identified as Citations A, B and C which represent information of which the applicants are aware of and which may be material to the examination of this application.

Certificate of Mailing (37 C.F.R. 1.8)
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: *Assistant Commissioner for Patents, Washington, D.C. 20231*, on (Date) 4-27-00.
Typed or printed name of person signing this certificate:
PATRICIA PRISCOLL
Signature: Patricia Priscoll

Citation A is the Brief of Plaintiff/Appellant Group One Ltd., the Assignee of the above-referenced Application in the litigation, Group One Ltd. v. Hallmark Cards, Inc. Applicant brings this document to the attention of the Examiner because it includes the Order of the Judge in the underlying case in which the Judge found that parent U.S. Patent No. 5,518,492 and parent U.S. Patent No. 5,711,752 were invalid under 35 U.S.C. §102(b) as being offered for sale before the critical date. Also enclosed is a detailed Brief filed with the United States Court of Appeals for the Federal Circuit outlining why the finding of invalidity of the parent patents was erroneous based upon the facts and the law.

Applicant considers the Order to be erroneous because it imposed an on-sale bar without a specific finding that there had been a definite offer for sale prior to the critical date of the parent applications. The court itself found the precritical date communications indefinite, lacking specific terms such as price, merely a preliminary proposal, and an invitation to negotiate since no disclosure was made prior to the critical date of anything at all about the invention itself. The District Court further erred by basing its holding of invalidity on its limited finding that the invention was ready for patenting prior to the critical date while at the same time, the District Court did not find that the invention was reduced to practice or ready for patenting at the time the alleged "offer to initiate negotiations" was made. This is a holding contrary to the decisions of Supreme Court. Furthermore, the Court erred because it considered that even an offer to license a technology is the same as the sale of the patented device and therefore fell within §102(b). However, this is contrary to the established precedent of the Federal Circuit. Lastly, the Court erred because there was no evidence to support the argument that Group One's activities should be interpreted as offer to license or sell patent rights as is more specifically outlined in the Appeal Brief.

Citation B is the Brief of Defendent-Appellee in the litigation, Group One Ltd. v. Hallmark Cards, Inc. and Citation C is the Reply thereto. Applicant brings this document to the attention of the Examiner because it is related to previously filed documents in this application.

A copy of each of the references is enclosed for the convenience of the Examiner.

This Statement is being filed prior to a first Office Action and therefore no fee is due. The Examiner is respectfully requested to consider and make the references of record in the subject application.

Respectfully submitted,

Howard M. Gitten
Registration No. 32,138
Attorney for Applicant
STROOCK & STROOCK & LAVAN LLP
180 Maiden Lane
New York, New York 10038-4982
(212) 806-6669